

**Upon further consideration of the last Office Action, the Office Action dated July 17, 2009 is vacated.**

**DETAILED ACTION**

1. In the remarks filed on April 20, 2009, Applicant amended claims 29-31, 39-42 and 44-46 and submitted arguments for allowability of pending claims 29-48.

***Response to Arguments***

2. Applicant's arguments, filed April 20, 2009, with respect to claims 29-38 have been fully considered and are persuasive. The rejections of claims 29-38 have been withdrawn.

3. Applicant's arguments, filed April 20, 2009, with respect to claims 39-45 have been fully considered.

Given Applicants removal of the term "controller" from claims 39-45, the 35 U.S.C. 112 first paragraph rejection of claims 39-45 with regard to the "controller" has been withdrawn. However, upon further consideration of the newly amended claims, a new rejection has been made (see the 35 U.S.C. 101 rejection below).

4. Applicant's arguments filed April 20, 2009, with respect to claims 46-48 have been fully considered but they are not persuasive.

**Regarding claims 46-48,** Applicant argues that the claimed "processor-readable medium" is supported by paragraphs [0005] and [0006] of the published disclosure and further that one skilled in the art would recognize that the optical device and optical disk system of paragraphs [0005] and [0006] would include a medium capable of storing instructions as claimed.

Examiner respectfully disagrees. Paragraphs [0005] and [0006] of the publication provide discussion of the related art and problems with the related art. There is no disclosure of a processor-readable medium or a processor-readable medium which stores instructions for discriminating a type of an optical storage medium, implied or inherently, in the referenced paragraphs or any other paragraphs in Applicants specification. As such, Examiner maintains that the specification fails to provide proper antecedent basis for the claimed subject matter and that claims 46-48 added September 15, 2008 is not supported by the as-filed disclosure and violates the written description requirement.

### ***Drawings***

**5.** The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the apparatus for discriminating a type of an optical storage medium and a processor-readable medium must be shown or the features canceled from the claims. **No new matter should be entered.**

Not only does the specification fail to contain a written description of the subject matter now recited in claims 39-48, but also none of the drawings show or describe the subject matter or features of claims 39-48.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

6. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). There should be clear support or antecedent basis in the specification for the terminology used in the claims. Applicant employs the term "processor-readable medium" in claims 46-48. The terms do not appear in the specification. Correction is required.

### ***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. **Claims 46-48 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.**

The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. New or amended claims which introduce elements or limitations which are not supported by the as-filed disclosure violate the written description requirement, i.e., are new matter. See MPEP § 2163 I(B).

**Regarding claims 46-48**, the original specification fails to disclose or contain a written description of a processor-readable medium that is for storing/implementing instructions for discriminating a type of an optical storage medium as now recited in claims 46-48.

***Claim Rejections - 35 USC § 101***

9. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

10. **Claims 39-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.**

**Claims 39-41** are drawn to a "computer program" *per se*, therefore, fail to fall within a statutory category of invention.

**Claims 39-41** are limited to an apparatus comprising a system having functions of measuring a distance between a reflection layer and a surface layer, determining a distance error and discriminating the type of optical storage medium. Figure 4 shows a flow diagram of these operations as method steps. As noted by Applicant in the remarks filed on April 20, 2009, these steps are inherently performed by a computer

program ("instructions") stored on a processor readable medium. As such, the only claimed element in the claimed apparatus is a system performing certain functions, which system reads on the alleged inherent computer program, per se.

A claim directed to a computer program itself is non-statutory because it is not:

A process occurring as a result of executing the program, or

A machine programmed to operate in accordance with the program, or

A manufacture structurally and functionally interconnected with the program in a manner which enable the program to act as a computer component and realize its functionality, or

A composition of matter.

***Allowable Subject Matter***

**11. Claims 29-48** are allowable over the prior art of record.

**Claims 39-41** must be rewritten or amended to overcome the rejection under 35 U.S.C. 101 set forth in this Office action.

**Claims 42-45** are objected to as being dependent upon a rejected base claim. It is noted that these claims are deemed statutory under 35 U.S.C. 101, since they are limited to a read function which inherently requires a statutory apparatus, i.e., a machine.

**Claims 46-48** must be rewritten or amended to overcome the rejection under 35 U.S.C. 112, 1<sup>st</sup> paragraph set forth in this Office action.

The following is an examiner's statement of reasons for allowance:

**Regarding claims 29-48**, none of the references of record, alone or in combination, suggest or fairly teach the limitations of independent claim 29 in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper. Although the prior art discloses a method for discriminating a type of an optical storage medium, comprising: employing at least an optical pickup to measure distance between a reflection layer of the optical storage medium and a surface layer of the optical storage medium; the prior art fails to disclose **determining a distance error of the measured distance between the reflection layer of the optical storage medium and the surface layer of the optical storage medium; if the distance error is less than a failure threshold, comparing the measured distance with a distance threshold to discriminate a type of the optical storage medium; and if the distance error is greater than or equal to the failure threshold, employing an alternate method to discriminate the type of the optical storage medium.**

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

**12.** Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LaTanya Bibbins whose telephone number is (571)270-1125. The examiner can normally be reached on Monday through Friday 7:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wayne Young can be reached on 571 272-7582. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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